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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,133	09/29/2003	Ronald P. Sansone	F-740	2498

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Pitney Bowes Inc.  
Intellectual Property and Technology Law Dept.  
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EXAMINER
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LIU, ERIC

ART UNIT	PAPER NUMBER
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3628

MAIL DATE	DELIVERY MODE
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06/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/674,133	<b>Applicant(s)</b> SANSONE ET AL.	
	<b>Examiner</b> Eric Liou	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-2,4 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4 and 7-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/12/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. Applicant has canceled claims 3 and 5-6 and amended claims 1,4, 9, and 17. Claims 18-19 have been added. Thus, claims 1-2, 4, and 7-19 are pending and are presented for examination.

### ***Claim Objections***

2. Claims 1, 4, and 17 are objected to because of minor informalities. Appropriate correction is required.
3. As per claim 1, the term "senders" should be changed to "sender's" in line 12.
4. As per claim 4, the term "changed" should be changed to "charged" in line 5. Appropriate correction is required.
5. As per claim 17, "a" should be changed to "an" in line 2.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9 and 11-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
8. Claim 9 recites "a second carrier's postage" in line 5. It is unclear if "a second carrier's postage" is the same amount charged by the sender's meter for the second carrier as stated in

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claim 1. The Examiner interprets "a second carrier's postage" (claim 9) to be the same amount as the postage charged for the second carrier as stated in claim 1.

9. Claim 11 recites the limitation "the amount of business reply mail" in line 2. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 16 recites the limitation "the total amount" in line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-2, 4, 7-11, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon, U.S. Publication No. 2004/0064422 in view of Schwartz et al., U.S. Publication No. 2002/0073040.

13. As per claim 1, Leon teaches a method for paying for international business reply mail that is processed by a second carrier located in a second country and a first carrier located in a first country, comprising the steps of: charging a sender's meter located in the first country for postage that is due to the carrier for processing business reply mail that is deposited by a recipient with the carrier (Leon: paragraphs 0031, 0101 and 0108); charging a sender's meter located in the first country for postage that is due to the carrier for business reply mail that is

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received from the carrier and delivered to a party located in the first country (Leon: paragraphs 0031, 0101 and 0108); paying the carrier the amount charged to the sender's meter for the carrier's postage (Leon: paragraphs: 0052 and 0081, "postal service account is credited").

14. Leon does not teach a second carrier, a second country, and paying the second carrier the amount charged to the sender's meter for the second carrier postage.

15. Schwartz teaches FedEx is a second carrier that may be used in the mailing system and method (Schwartz: Figure 7, paragraphs 0010-0011, "FedEx" is a second courier different from the postal authority.). Schwartz further teaches paying the second carrier the amount charged to the sender's meter for the second carrier postage (Schwartz: paragraphs 0010 and 0059).

Schwartz does not teach sending mail between two countries (a second country). However, Official Notice is taken that it was old and well known in the art of the shipping industry that FedEx is an international shipping carrier that regularly ships between different countries. It would have been obvious to have modified Schwartz to include the teachings of Official Notice because shipping to multiple countries allows businesses to interact globally, that is, on a much larger scale than domestically.

16. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Leon to have included a second carrier and paying the second carrier the amount charged to the sender's meter for the second carrier postage as taught by Schwartz for the advantage of providing a method that enables the efficient shipment of international mail.

17. As per claim 2, Leon in view of Schwartz teaches the method of claim 1 as described above. Leon further teaches the party is the sender (Leon: paragraph 0031).

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18. As per claim 4, Leon in view of Schwartz teaches the method of claim 1 as described above. Leon further teaches printing on the business reply mail an indication of the amount of postage charged to the sender's meter for the carrier's postage (Leon: paragraph 0070, "machine-readable portion 65", Figure 4, "65 reply", and paragraph 0099). Leon does not teach printing an indication of the amount of postage charged for the second carrier's postage.

19. Schwartz teaches printing an indication of the amount of postage charged for the second carrier's postage (Schwartz: Figure 7, "708" and paragraphs 0010-0011 and 0059).

20. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Leon in view of Schwartz to have included printing an indication of the amount of postage charged for the second carrier's postage as taught by Schwartz for the advantage of creating a record of the dues owed to a particular carrier (Schwartz: paragraphs 0059-0060).

21. As per claim 7, Leon in view of Schwartz teaches the method of claim 1 as described above. Leon further teaches delivering an item containing the international business reply mail from a sender located in the first country to a recipient (Leon: paragraphs 0031, 0105, and 0107). Leon does not teach the second country.

22. Schwartz teaches FedEx is a second carrier that may be used in the mailing system and method (Schwartz: Figure 7, paragraphs 0010-0011, "FedEx" is a second courier different from the postal authority.). Official Notice is taken that it was old and well known in the art of the shipping industry that FedEx is an international shipping carrier that regularly ships between different countries, i.e. a second country. It would have been obvious to have modified Schwartz

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to include the teachings of Official Notice because shipping to multiple countries allows businesses to interact globally, that is, on a much larger scale than domestically.

23. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Leon in view of Schwartz to have included a second country as taught by Schwartz and Official Notice for the advantage of providing a method that enables the efficient shipment of international mail.

24. As per claim 8, Leon in view of Schwartz teaches the method of claim 7 as described above. Leon further teaches charging the sender's meter for delivering the item (Leon: paragraphs 0031, 0101, 0108, 0112, and 0122);

25. As per claim 9, Leon in view of Schwartz teaches the method of claim 8 as described above. Leon further teaches printing on the item an indication of the amount of postage charged to the sender's meter for the carrier's postage (Leon: paragraph 0070, "machine-readable portion 65", Figure 4, "65 reply", and paragraph 0099). Leon does not teach printing an indication of the amount of postage charged for a second carrier's postage.

26. Schwartz teaches printing an indication of the amount of postage charged for the second carrier's postage (Schwartz: Figure 7, "708" and paragraphs 0010-0011 and 0059).

27. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Leon in view of Schwartz to have included printing an indication of the amount of postage charged for a second carrier's postage as taught by Schwartz for the advantage of creating a record of the dues owed to a particular carrier (Schwartz: paragraphs 0059-0060).

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28. As per claim 10, Leon in view of Schwartz teaches the method of claim 7 as described above. Leon further teaches paying the carrier the amount charged to the sender's meter for delivering the item (Leon: paragraphs 0031 and 0033, "debits the mailer's account for postage"). Leon does not teach paying the second carrier the amount charged.

29. Schwartz teaches paying the second carrier the amount charged (Schwartz: paragraph 0010).

30. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Leon in view of Schwartz to have included paying the second carrier the amount charged as taught by Schwartz for the advantage of compensating a carrier for services rendered to a sender.

31. As per claim 11, Leon in view of Schwartz teaches the method of claim 7 as described above. Leon further teaches indicating on the item the amount of business reply mail that may be returned to the sender (Leon: Figure 4 and paragraph 0099 – The Examiner interprets the reply segment 75 to indicate that one business reply mail response may be returned to the sender).

32. As per claim 18, Leon in view of Schwartz teaches the method of claim 1 as described above. Leon further teaches the sender's meter is a postage meter (Leon: Figure 6 and paragraph 0112).

33. As per claim 19, Leon in view of Schwartz teaches the method of claim 1 as described above. Leon further teaches printing a country indicia on the business reply mail to indicate the amount of postage due to the carrier (Leon: paragraph 0070, "machine-readable portion 65",



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Figure 4, “65 reply”, and paragraph 0099). Leon does not teach printing second country indicia on the mail to indicate the amount of postage due to the second carrier.

34. Schwartz teaches printing a second carrier indicia on the mail to indicate the amount of postage due to the second carrier (Schwartz: Figure 7, “708” and paragraphs 0010-0011, “FedEx” and 0059). Schwartz does not teach a second country indicia. However, Official Notice is taken that it was old and well known in the art of the shipping industry that FedEx is an international shipping carrier that regularly ships between different countries. Therefore, the Examiner interprets the FedEx indicia (Schwartz: Figure 7, “708”) to be the second country indicia. It would have been obvious to have modified Schwartz to include the teachings of Official Notice because shipping to multiple countries allows businesses to interact globally, that is, on a much larger scale than domestically.

35. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Leon in view of Schwartz to have included printing a second carrier indicia on the mail to indicate the amount of postage due to the second carrier as taught by Schwartz for the advantage of creating a record of the dues owed to a particular carrier (Schwartz: paragraphs 0059-0060).

36. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon, U.S. Publication No. 2004/0064422 in view of Schwartz et al., U.S. Publication No. 2002/0073040 and further in view of Walker et al., U.S. Patent No. 6,978,248.

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37. As per claim 12, Leon in view of Schwartz teaches the method of claim 11 as described above. Leon in view of Schwartz does not teach determining an expected business reply response factor for the business reply mailing.

38. Walker teaches determining an expected business reply response factor for the business reply mailing (Walker: column 11, lines 49-52, "response rate").

39. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Leon in view of Schwartz to have included determining an expected business reply response factor for the business reply mailing as taught by Walker for the advantage of providing an efficient and cost effective way of testing, selecting, and creating a mailing list that is appropriate to a business's needs (Walker: column 12, lines 20-23).

40. As per claim 13, Leon in view of Schwartz and further in view of Walker teaches the method of claim 12 as described above. Leon further teaches determining a cost of mailing the expected business reply responses (Leon: paragraphs 0031, 0101 and 0108 – The Examiner notes, charging the mailer suggests the prior step of determining a cost of mailing.).

41. As per claim 14, Leon in view of Schwartz and further in view of Walker teaches the method of claim 13 as described above. Leon further teaches charging the sender's meter for the cost of mailing the expected business reply responses (Leon: paragraphs 0031, 0101, 0108, 0112, and 0122).

42. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon, U.S. Publication No. 2004/0064422 in view of Schwartz et al., U.S. Publication No. 2002/0073040

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and in view of Walker et al., U.S. Patent No. 6,978,248 and further in view of Baer et al., U.S. Patent No. 4,999,481.

43. As per claim 15, Leon in view of Schwartz and further in view of Walker teaches the method of claim 14 as described above. Leon in view of Schwartz teaches international business reply mail and the first and second carriers as described above. Leon in view of Schwartz and further in view of Walker does not teach counting the number of mail processed.

44. Baer teaches counting the number of mail processed (Baer: column 5, lines 48-50 and column 6, lines 42-44).

45. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Leon in view of Schwartz and further in view of Walker to have included counting the number of mail processed as taught by Baer for the advantage of maintaining a record for a batch of mail (Baer: column 6, lines 56-60).

46. As per claim 16, Leon in view of Schwartz in view of Walker and further in view of Baer teaches the method of claim 15 as described above. Leon in view of Schwartz teaches international business reply mail and the first and second carriers as described above. Leon in view of Schwartz and further in view of Walker does not teach determining the total amount of postage due for the counted mail.

47. Baer teaches determining the total amount of postage due for the counted mail (Baer: column 4, lines 63-68 – column 5, lines 1-9).

48. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Leon in view of Schwartz in view of Walker and further in view of Baer to have included determining the total amount of postage due for the

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counted mail as taught by Baer for the advantage of maintaining a record for a batch of mail (Baer: column 6, lines 56-60).

49. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leon in view of Schwartz and further in view of Fredman, U.S. Patent No. 6,526,393.

50. As per claim 17, Leon in view of Schwartz teaches the method of claim 7 as described above. Leon in view of Schwartz teaches international business reply mail as described above. Leon in view of Schwartz does not teach indicating on the mail an expiration date that the sender's meter will be charged for processing specific batches of mail.

51. Fredman teaches indicating on the mail an expiration date that the sender's meter will be charged for processing specific batches of mail (Fredman: Figure 1 and column 2, lines 17-19).

52. It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Leon in view of Schwartz to have included indicating on the mail an expiration date that the sender's meter will be charged for processing specific batches of mail as taught by Fredman for the advantage of providing an important incentive to facilitate and increase a recipient's rate of response (Fredman: column 2, lines 38-40).

### ***Conclusion***

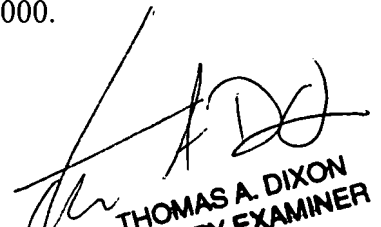
53. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Critelli et al., U.S. Publication No. 2003/0093389, drawn to a method to account for domestic and international mail fees. [www.fedex.com/us/about/corporation](http://www.fedex.com/us/about/corporation), drawn to FedEx as an international carrier.

The Examiner has cited particular portions of the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the Applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Liou whose telephone number is 571-270-1359. The examiner can normally be reached on Monday - Friday, 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
THOMAS A. DIXON  
PRIMARY EXAMINER